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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/626,954

07/27/2000

Frederick W. Ryan JR.

F-173

9430

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7590

11/30/2006

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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,954

Applicant(s)

RYAN, FREDERICK W.

Examiner

Igor Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 21-26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21-26 and 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

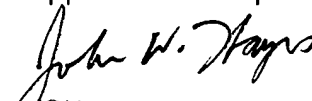
In view of the Appeal Brief filed on 10/03/2005 PROSECUTION IS HEREBY REOPENED, as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 includes the following step:

"transmitting a registration ID number, provided by the mail campaign sender to a user, from the postage metering system to a data center, the registration ID number being associated with a delivery address previously defined by the mail campaign sender and disclosed in human readable form to the user of the postage metering system", which is confusing. So as the following limitation: "previously defined by the

mail campaign sender and disclosed in human readable form to the user of the postage metering system" is not positively claimed, it is not clear should it be given patentable weight.

Claim 9 recites the following limitation:

"supplying the registration ID number, the business reply mail piece and delivery address in human readable form to a user of a postage metering system, where the registration ID number is used by the user to print a postal indicium on the business reply mail piece including data relating to the delivery address." So as the following limitation: "*where the registration ID number is used by the user to print a postal indicium on the business reply mail piece including data relating to the delivery address*" is not positively claimed, it is not clear should it be given patentable weight.

Same or similar reasoning applied to the remaining claims.

For claim 15, it is totally unclear what is being claimed here.

If claim 15 refers to an apparatus (device), then the body of the claim is confusing:

"a plurality of mail campaign sender accounts associated with respective mail campaign senders, where each of the plurality of mail campaign sender accounts includes a registration ID number associated with a delivery address and a particular mail campaign of which a business reply mail piece is a part, respectively, where said registration ID number is used to generate a postage indicium, and where said postage indicium and delivery address in human readable form are provided to a user of a postage metering system." It is not clear to what extend the terms "accounts" and "registration ID number" represent structural elements. Furthermore, language as to: "*where said registration ID number is used to generate a postage indicium, and where said postage indicium and delivery address in human readable form are provided to a user of a postage metering system*" indicates the intended use of the apparatus (device), and, therefore, should not be given a patentable weight (MPEP 2106 (II) (C))

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states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.").

If claim 15 supposed to claim a computer-readable medium having computer-readable instruction for causing a computer to implement a method, then the claim completely lacks the recitation of specific instructions which would enable certain functionality if executed by a computer.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to an apparatus, while the body of the claim recite merely data structure or code per se. Therefore, the claim is directed to nonstatutory functional descriptive material. See MPEP 2106(IV)(B)(1)(a).

Claim Rejections - 35 USC § 103

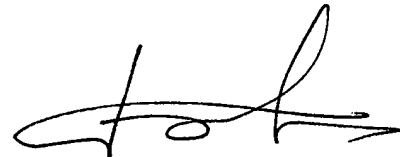
Claim Rejections under 35 USC § 103 have been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
11/21/2006



IGOR N. BORISSOV
PRIMARY EXAMINER